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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,389	07/09/2003	Motoki Kakui	50212-514	8492

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Washington, DC 20005-3096

EXAMINER

DIACOU, ARI M

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,389

Applicant(s)

KAKUI ET AL.

Examiner

Ari M. Diacou

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 28-34 is/are pending in the application.
- 4a) Of the above claim(s) 13-27 and 35-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 28-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of invention A, I corresponding to claims 1-12 and 28-34 in the reply filed on July 19, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 13-27 and 35-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 19, 2005.

Specification

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The specification is rejected under 35 U.S.C. 112, first paragraph, as failing to provide an adequate written description of the invention and as failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure.

There is no adequate description nor enabling disclosure of the parameters of a specific operative embodiments of the invention, including: the exact (including degree of purity and the impurities present) of the Bi oxide materials utilized in the operation of the applicants invention.

It is noted that the specification appears to set forth some parameters (see page 6, ¶ 2); however the specification does not set forth an example of an operative embodiment wherein specific values for each of the parameters are recited.

Claim Rejections - 35 USC § 112

5. Claims 1-12, and 28-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The reasons that the inventions as disclosed are not enabling are the same as the reasons set forth in section 2 above as to why the specification is objected to and the reasons set forth in section 2 are accordingly incorporated within.

6. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The use of "B element" construed to refer to the element Boron, is not disclosed in the specification. It appears that "B" should actually be "Bi".

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 3, 5, 7, 9, 11-12, and 28-30, the phrase "type" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Thus, the composition of the Bi oxide is construed to be indefinite. See MPEP § 2173.05(c).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1, 3, 5, 7, 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroiwa et al.

Regarding claim 1, Kuroiwa discloses an optical amplification module for collectively amplifying signal light having multiplexed a plurality of channels in a signal wavelength band including a wavelength region having a wavelength of 1610 nm or longer [Fig. 1], said optical amplification module comprising:

a Bi optical waveguide, comprised of Bi oxide host glass, including an optical waveguide region doped with Er element, for propagating the signal light; [¶ 1, line 4]

and a pumping light supply system for supplying the optical waveguide region with pumping light so as to generate a population inversion within the optical waveguide region of said Bi optical waveguide. [¶ 1, line 10]

Regarding claim 3, Kuroiwa discloses an optical amplification module according to claim 1, further comprising a control unit [¶ 2, line 3-6] *for adjusting an optical power of the pumping light supplied from said pumping light supply system to said Bi type optical waveguide so as to yield a relative gain non-uniformity of less than 25% in a net gain spectrum of said Bi optical waveguide at a predetermined operating temperature within an operating temperature range of said optical amplification module.*

Regarding claim 5, Kuroiwa discloses an optical amplification module according to claim 1, further comprising a control unit [¶ 2, line 3-6] *for adjusting an optical power of the pumping light supplied from said pumping light supply system to said Bi optical waveguide so as to yield a relative gain non-uniformity of less than 25% in a net gain spectrum of said Bi optical waveguide within a whole operating temperature range of said optical amplification module.*

Regarding claim 7, Kuroiwa discloses an optical amplification module according to claim 1, further comprising a control unit [¶ 2, line 3-6] *for adjusting an optical power of the pumping light supplied from said pumping light supply system to said Bi optical waveguide so as to yield a relative gain non-uniformity of less than 25% in a net gain spectrum of said Bi optical waveguide in a wavelength bandwidth exceeding 37 nm within a whole operating temperature range of said optical amplification module.*

Regarding claim 9, Kuroiwa discloses an optical amplification module according to claim 1, further comprising a control unit [¶ 2, line 3-6] *for adjusting an optical power of the pumping light supplied from said pumping light supply system to said Bi optical waveguide so as to yield a relative gain non-uniformity of less than 19% in a net gain spectrum of said Bi optical waveguide in a wavelength bandwidth exceeding 37 nm within a whole operating temperature range of said optical amplification module.*

11. In claims 3, 5, 7, 9, and 33 the “for...” clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

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See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Conclusion

12. The prior art which is cited but not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ari M. Diacou whose telephone number is (571) 272-5591. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMD 8-1-2005


JACK KEITH
PRIMARY EXAMINER
SPE 3663